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OFFICE OF PETITIONS

In re Patent No. 7,442,694 :
Coe et al. : LETTER REGARDING PATENT
Issue Date: October 28, 2008 : TERM ADJUSTMENT AND
Application No. 10/657,738 : NOTICE OF INTENT TO ISSUE
Filed: September 8, 2003 : CERTIFICATE OF CORRECTION
Attorney Docket No. PC25077A :

This letter is in response to the "Letter in Compliance with A Practitioner's Duty of Candor and Good Faith Request Review of PTA under 37 CFR 1.700," filed October 8, 2008, which is properly treated as a request that the determination of patent term adjustment under 35 U.S.C. 154(b) be reviewed for accuracy.

The request for review of the determination of patent term adjustment is GRANTED to the extent indicated herein.

Patentees are given TWO (2) MONTHS from the mailing date of this decision to respond. No extensions of time will be granted under 37 CFR 1.136.

The patent term adjustment indicated in the patent is to be corrected by issuance of a certificate of correction showing a revised patent term adjustment of 243 days.

On August 15, 2008, the Office mailed the initial Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment was 30 days. On October 8, 2008, applicants submitted the instant comment. On October 28, 2008, the above-identified application matured into U.S. Patent No. 7,442,694, with a revised determination of patent term adjustment of 280 days.

Patentees disclose that they believe that determination of patent term adjustment is incorrect and that they should have been assessed a delay under 37 CFR 1.703(c) for the abandonment of the application. Additionally, patentees contend that period of reduction of 215 days under 37 CFR 1.704(b) "is moot in light of the reduction under 37 CFR 1.704(c)(3)." Letter dated 10/08/08, p. 1.

The application history has been reviewed and it has been determined that the revised determination of patent term adjustment of 280 days is incorrect.

Pursuant to 37 CFR 1.704:

(c) Circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping.

(3) Abandonment of the application or late payment of the issue fee, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the date of abandonment or the date after the date the issue fee was due and ending on the earlier of:

(i) The date of mailing of the decision reviving the application or accepting late payment of the issue fee; or

(ii) The date that is four months after the date the grantable petition to revive the application or accept late payment of the issue fee was filed[.]

A review of the record reveals that patentees should have been assessed a delay of 248 days for the abandonment of the application. See 37 CFR 1.704(c)(3)(ii). A final Office action was mailed on September 28, 2006, which set a three-month shortened statutory period for reply. On March 27, 2007, patentees obtained an extension of time for response within the third month. However, patentees did not file a timely and proper reply to the final Office action within the six-month

statutory response period. Thus, the application became abandoned on March 29, 2007. On July 31, 2007, patentees submitted a petition under 37 CFR 1.137(b) to revive the application, a petition fee, a proper statement of unintentional delay, and a reply in the form of a Notice of Appeal. A decision granting the petition to revive was mailed on February 12, 2008. Accordingly, a period of reduction of 248 days should have been entered; counting the number of days beginning on the date of abandonment, March 29, 2007, and ending on the earlier of the date that is four months after the date the grantable petition to revive the application was filed, December 1, 2007. See 37 CFR 1.704(c)(3)(ii). Accordingly, a period of reduction of 248 days will be entered.

Additionally, patentees are correct that the period of reduction under 37 CFR 1.704(b) of 215 days for the filing of the Notice of Appeal on July 31, 2007, is not warranted. Accordingly, the period of reduction of 215 days will be removed.

Lastly, it appears that the period of adjustment under 37 CFR 1.702(b)(1)¹ of 585 days is incorrect. The record reveals that patentees filed a RCE on April 11, 2008. Thus, the RCE cuts-off the ability to accumulate additional patent term adjustment against the three-year pendency provision, but does not otherwise effect patent term adjustment. Accordingly, the period of adjustment under 37 CFR 1.702(b) should be 581 days (not 585 days), counting the number of days beginning on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a), September 9, 2006,

¹ 37 CFR 1.702(b)(1) provides:

Failure to issue a patent within three years of the actual filing date of the application. Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to issue a patent within three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application, but not including:

- (1) Any time consumed by continued examination of the application under 35 U.S.C. 132(b) [.]

and ending on the date the RCE was filed, April 11, 2008. See 37 CFR 1.703(b)(1)². However, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application, which overlap, with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. Further, in considering the overlap, the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). See 35 U.S.C. 154(b)(1)(B); 35 U.S.C. 154(b)(2)(A); and 37 CFR 1.703(f). See also Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule, 69 Fed. Reg. 21704 (April 22, 2004). In this instance, the period of delay of 581 days attributable to the delay in the issuance of the patent overlaps with the adjustment of 335 days attributable to grounds specified in § 1.702(a)(1) and (2). Thus, at issuance, only an additional period of adjustment of 246 days (not 250 days) should have been entered for Office delay for a total of 581 days.

In view thereof, the patent should have issued with a revised patent term adjustment of **243 days** (581 days of Office delay - 338 days of applicant delay).

As this letter was submitted as an advisement to the Office of an error in patentees' favor, the Office will not assess the \$200.00 fee under 37 CFR 1.18(e). The Office thanks patentees

² 37 CFR 1.703(b) provides:

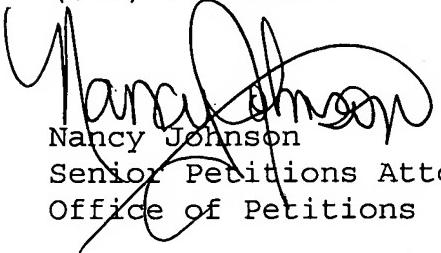
The period of adjustment under § 1.702(b) is the number of days, if any, in the period beginning on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application and ending on the date a patent was issued, but not including the sum of the following periods:

(1) The number of days, if any, in the period beginning on the date on which a request for continued examination of the application under 35 U.S.C. 132(b) was filed and ending on the date the patent was issued[.]

for patentees' good faith and candor in bringing this to the attention of the Office.

The application is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify this error. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by 243 days.

Telephone inquiries specific to this matter should be directed to Christina Tartera Donnell, Senior Petitions Attorney, at (571) 272-3211.


Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

DRAFT COPY

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT : 7,442,694 B2

DATED : Oct. 28, 2008

INVENTOR(S) : Coe et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by (280) days

Delete the phrase "by 280 days" and insert – by 243 days--